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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,071	06/22/2001	Arturo De La Cruz	WEAT/0122	6610

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EXAMINER	
SAETHER, FLEMMING	
ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/888,071	CRUZ ET AL.01	
	Examiner	Art Unit	
	Flemming Saether	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 24-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 24-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-9 and 24-26 rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The claims require the threads to be "fully cold formed" in combination with certain hardness specifically of about 27-32 HRC which, would not be possible according to the prior art incorporated by reference (Hermanson, US 5,334,268). Indeed, Hermanson describes the hardness as greater than 23 HRC (column 3, line 22), which is even less than that required by the instant invention, and concludes that "owing to the hardness" a different procedure is required wherein the threads are first cut prior to cold working (column 3, last paragraph). Therefore, in view of Hermanson's disclosure, the instant invention would be inoperative because when the hardness is between 27 and 32 HRC, the threads could not be fully cold formed. The claims were examined as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hermanson (US 5,334,268). Hermanson discloses a sucker rod coupling comprising a hollow cylindrical coupling (12) having internal threads and an outer wear layer. The wear layer comprises a hardness of greater than 40 HRC (column 3, line 45-48), a thickness of at least 0.010 inches (column 3, line 33), a surface finish of 63Ra (column 3, line 52) and is a 76-M-50-S spray metal (column 3, line 36). The hardness of the coupling is greater then 23 HRC which is inclusive of the claimed range. The specific spray would inherently be within the claimed mesh range and the steel is a low carbon, alloy steel. The threads being fully cold formed by rolling, the wear layer being sprayed on and the tempering to provide the hardness are product-by-process limitations wherein only the final product is considered for patentability. See In re Mrosi, 218 USPQ 289 (Fed. Cir. 1983).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hermanson as applied to claim 1 above, and further in view of Rallis (US 6,413,326). Hermanson does not disclose the specific metal of the coupling. Rallis disclose a coupling to be made of the AISI 4130 or an AISI 8630 steel (column 4, line 63,64). At

the time the invention was made, it would have been obvious for one of ordinary skill in the art to make the coupling of Hermanson out of AISI 4134 or AISI 8630 as disclosed in Rallis since Hermanson discloses "any capable metal" (column 3, line 14) and Rallis disclose an equivalent steel.

In response to Remarks

Regarding the rejection under 35 USC 101 applicant argues that the disclosure of the prior art (Hermanson) which the examiner relied upon for the rejection is "misleading". In response, the examiner is not in a position to dispute the teaching of Hermanson and as such must consider it accurate and in turn maintain the 101 rejection. Applicant is invited to provide evidence that the teaching of Hermanson is misleading or inaccurate in support that the instant invention is operative.

Applicant next argues that the threads being fully cold formed by rolling is product-by-process limitation. In response, the examiner is aware that product-by-process limitations are proper as a way to define a product however; it is the final product which is considered for patent and not the process. In the instant case, the final product is a hardened thread which is what is taught in Hermanson. Furthermore, Hermanson has hardened threads which are even rolled and could be considered as "fully rolled" since Hermanson that it is impossible for the threads to be more rolled. Applicant should consider using quantitive values to show the threads of the instant invention are harder or stronger than those of Hermanson taking care not to introduce

new matter alternatively, applicant should consider filing an application to the method claims.

No response is believed necessary to applicant remarks regarding Hermanson in view of Rallis because applicant is relying on the same argument as addressed above.

Lastly, the examiner has considered the conclusion of the European IPER but, as recognized by applicant the finding of the IPER are not binding. Other authorities have differing rules and regulation governing patents and, for the reasons discussed above, when the claims of the instant invention are considered in accordance with USPTO rules and regulations they are not patentable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Flemming Saether
Primary Examiner
Art Unit 3679